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JUL 13 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: YAMAMOTO, et al.
Application No. 10/806,099
Filed: March 23, 2004
For: CONFIGURATION MANAGEMENT
APPARATUS AND METHOD

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a response to the petition filed 06 June 2005 and supplemented by the further submission of 13 June 2005 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

The Petition is DISMISSED.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, **applicant will be notified and the defects in the request will be stated.** The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner.

The petition filed 06 June 2005 and supplemented on 13 June 2005 fails to adequately meet requirement (e) of the criteria set forth above. The discussion of the references does not point out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references.

The petition identifies a feature of each independent claim (i.e., a first feature of independent claim 1, . . . , a ninth feature of independent claim 20). However, in identifying this feature, the discussion states that the references “fail to disclose or suggest [the identified feature] *in combination* with the other limitations recited in the claims” (emphasis added). It is also stated in the discussion of each reference that the reference “does not disclose or suggest” the identified feature for each independent claim “*in combination* with the other limitations recited in each of the independent claims” (emphasis added). In effect, this statement indicates that the *entirety* of the nine independent claims is not disclosed by the ten references purported to be most closely related. Such a statement is not a sufficient detailed description. Applicants may wish to consider deleting the portions of the discussion that indicate that the identified features *in combination* with the other limitations are not disclosed by the references. Also, it is suggested that if the identical statement is being made to distinguish each reference from the claims, as in the supplemental petition, then the statement should simply be made once in the petition. (E.g., “None of the references disclose . . . ”)

The discussion also states that, for each of the ten references deemed most closely related, the reference fails to disclose a “third step for preparing a cache allocation definition of a logical volume of said second storage . . . said second storage device has.” However, it is unclear what is intended by the discussion of this particular feature when this feature does not even appear in most of the independent claims. (The feature is recited *verbatim* in claims 1 and 10. However, in claims 6, 9, 10, 11, 16, 19, and 20, it is recited with some variations, and in claim 5, it is recited with substantial variation.)

Finally, on page 7, the discussion states that “although the distinguishing feature(s) may represent a substantial portion of the claimed invention, the claimed invention including said feature(s) and their interoperation provides a novel storage system and system and method related to or implemented in or by said storage system not taught or suggested by any of the references of record.” However, it is not clear what is intended by this statement. The statement fails to explain why “the distinguishing feature(s) may represent a substantial portion of the claimed invention”.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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